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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 693

VICTOR DECOSTA, *Petitioner,*

v.

COLUMBIA BROADCASTING SYSTEM, INC., CAPITAL CITIES BROADCASTING CORPORATION and C B S FILMS INC., *Respondents.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The petitioner, Victor DeCosta, prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the First Circuit entered in this proceeding on May 11, 1967.

OPINION BELOW

The opinion of the United States Court of Appeals for the First Circuit is reported at 377 F.2d 315 and is reprinted in the Appendix hereto, p. 1a, *infra*. No opinion was rendered by the United States District Court for the District of Rhode Island.

JURISDICTION

The opinion and judgment of the Court of Appeals were entered on May 11, 1967. On timely application, Mr. Justice White on July 25, 1967, signed an order extending the time for filing this petition for writ of certiorari to and including October 7, 1967. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Whether, as a matter of federal law, the creator of a personal or literary characterization is entitled to recover damages for the unfair appropriation of the creative effort and creative development devoted to that characterization.

2. Whether federal copyright law preempts any effort under state law to protect the creator of a personal or literary characterization against unfair appropriation of the creative effort and creative development devoted to that characterization.

3. Whether literary characters are copyrightable under the federal copyright laws and are encompassed within the copyright clause of the United States Constitution, Art. I, § 8, cl. 8.

4. Whether common law copyright protection of a literary characterization, as guaranteed by 17 U.S.C.

§ 2, can be considered abandoned by virtue of what a federal appellate court determines is a publication where (a) the jury has found, on proper instructions and with supporting evidence, that there was no publication, and (b) the so-called publication involved only one manifestation rather than the essence of the characterization.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

United States Constitution, Art. I, § 8, cl. 8:

The Congress shall have power . . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

United States Code, Title 17:

§ 1. *Exclusive rights as to copyrighted works*

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;

* * * * * * * * *

§ 2. *Rights of author or proprietor of unpublished work*

Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.

§ 5. *Classification of works for registration*

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

* * * * * * * * *

(g) Works of art; models or designs for works of art.

* * * * * * * * *

(k) Prints and pictorial illustrations including prints or labels used for articles of merchandise.

STATEMENT OF THE CASE

Petitioner, a citizen and resident of Rhode Island, instituted this suit in the United States District Court for the District of Rhode Island against the respondent foreign corporations, jurisdiction being grounded upon diversity of citizenship within the meaning of 28 U.S.C. § 1332. The first cause of action alleged in the third amended complaint, which was the only matter submitted to the jury, asserted that the respondent corporations had "substantially capitalized upon the idea and promotions of the Plaintiff, the Defendants . . . [having] failed to adequately compensate the Plaintiff for his services, by means of which the Defendants and each of them have become unjustly enriched." R.App. 14-16. Damages were accordingly sought in the amount of $2,000,000.

The jury was instructed, without objection by respondents, that petitioner was entitled to verdicts in his favor if he established (1) that he conceived and created the idea and character of "Paladin, Have Gun Will Travel", and that said idea and character were novel, original and unique, and that he did not

at any time abandon said idea and character by a publication thereof; (2) that the respondents copied said idea and character without petitioner's permission and used them in the television series entitled "Have Gun Will Travel"; and (3) that petitioner sustained damages as a result of such copying and use of said idea and character. R.App. 357; and see p. 7a, *infra.*

Based upon these instructions, the jury found in favor of the petitioner and awarded him verdicts in the sums of $100,000 against respondent, Columbia Broadcasting System, Inc., $10,000 against the respondent Capital Cities Broadcasting Corporation, and $40,000 against the respondent C B S Films Inc. R.App. 368. Respondents' motions for a directed verdict having been denied by the court at the close of petitioner's case, at the conclusion of all the evidence and after the jury verdicts, judgments for the stated sums were entered pursuant to Rule 54(b). R.App. 406-407. Separate appeals from the three judgments were taken to the First Circuit by the respondents, which appeals were consolidated. All three judgments were thereupon reversed.

The facts as found and believed by the jury are fairly summarized in the opinion of the First Circuit, see Appendix hereto, pp. 2a-5a, *infra,* and may be briefly stated as follows:

Petitioner is a Rhode Island mechanic who acquired a "passion for all things western" as a result of his early experiences as a Texas range hand and a resident of hobo jungles. Following two years of riding and roping he returned to Rhode Island and has since devoted himself to the mechanic's trade.

Beginning in 1947, petitioner indulged in his hobby of dressing in a western costume and riding on his horse in rodeos, horse shows, horse auctions and parades throughout New England. Being equipped with a moustache, he then selected a costume composed of a black shirt, black pants and a flat-crowned black hat to which was attached a St. Mary's medal. He adopted the name "Paladin" from an epithet once hurled at him by an onlooker of Italian descent. And from a cry uttered by another onlooker he acquired the phrase "Have Gun Will Travel."

Petitioner added further touches to his characterization. He used as his symbol a chess knight, designed from a piece he had acquired for fifteen cents at an auction. This symbol appeared on his holster and on his business cards. The cards also contained the words "Have", "Gun", "Will", "Travel" and "Wire Paladin, N. Court St., Cranston, R. I." An antique derringer was strapped under his arm during his performances.

Thus garbed and equipped, petitioner would appear at various functions—riding his horse, staging a western gunfight with his derringer, and passing out his business cards and photographs of himself. Some 250,000 of the cards were distributed. And in the words of the First Circuit, see p. 3a, *infra*: "Children clamored for the cards, and clustered about him to the extent that he was likened to the Pied Piper and Gene Autry. This was perhaps one of the purest promotions ever staged, for plaintiff did not seek anything but the entertainment of others. He sold no product, services, or institution, charged no fees, and exploited only himself."

Some ten years after petitioner began playing this role of Paladin he and his friends saw the first CBS television production of "Have Gun Will Travel", starring moustachioed Richard Boone as "an elegant knight errant of the Old West, always on the side of Good—for a fee." See pp. 3a-4a, *infra*. Like the petitioner, this television hero was named Paladin and wore a black costume, a flat-crowned black hat bearing an oval silver decoration, and a silver chess knight on his holster. And the television Paladin would announce himself with a card featuring a chess piece. This card was in most respects so identical with petitioner's as to be a "Chinese copy." It bore the words "Have Gun Will Travel, Wire Paladin, San Francisco." This "Have Gun Will Travel" series was a commercial success, grossing more than $14,000,000. There were 225 first-run episodes appearing in the United States and licensed in foreign countries.

Various witnesses for the respondent corporations testified that they had never seen or heard of the petitioner or his cards or his activities and that they had independently conceived and developed the television character of Paladin and all the accoutrements associated with him. See pp. 4a-5a, *infra*. Any similarities were said to be purely coincidental. But as the First Circuit noted, pp. 2a, 5a, *infra*, this was a case of "'coincidence' run riot. . . . The jury obviously disbelieved at least this much of their testimony, and we think it clear that they were amply justified. Thus, the plaintiff has had the satisfaction of proving the defendants pirates."

The First Circuit felt that the judgments allowing petitioner to recover a total of $150,000 were supportable only "on a rule of law that would allow recovery

upon proof of creation by the plaintiff and copying by the defendants, and nothing else." See p. 7a, *infra*. In finding no such rule and accordingly reversing the judgments, the First Circuit ruled that:

(1) The leading case affording a remedy for mere copying, *International News Service* v. *Associated Press,* 248 U.S. 215, is no longer authoritative since (a) it was decided as a matter of general federal law prior to the ruling in *Erie R.R.* v. *Tompkins,* 304 U.S. 64, and (b) it has been overruled by the recent decisions in *Sears, Roebuck & Co.* v. *Stiffel Co.,* 376 U.S. 225, and *Compco Corp.* v. *Day-Brite Lighting, Inc.,* 376 U.S. 234.

(2) While the *Sears* and *Compco* decisions dealt with copying articles covered by invalid design patents, their rationale covers the copying of "writings" as referred to in the copyright provision of the United States Constitution, Art. I, § 8. And hence "writings" that have not been subjected to the Congressional scheme of protection by notice and registration are controlled by "the federal policy favoring free dissemination of intellectual creations." See p. 9a, *infra*. Such "writings" cannot be protected against copying by others.

(3) There come a point, and it may have been reached here, "where what is created is so slight a thing as not to warrant protection by any law." See p. 11a, *infra*.

(4) The business cards created and distributed by petitioner fully conveyed petitioner's characterization of "Paladin." As such, these cards were said to be unquestionably "writings" within the meaning of the copyright clause of the Constitution and were argu-

ably copyrightable under the copyright statute, 17 U.S.C. §§ 1, 5(g), 5(k). And while the jury had been instructed that it could find for the petitioner only if there had been no publication, the First Circuit ignored the jury determination and proclaimed that the passing out of the cards over the years to all who would have them constituted a publication by petitioner; hence petitioner was precluded from seeking protection under 17 U.S.C. § 2, which permits the owner of an unpublished work to invoke common law and equitable remedies to prevent copying.

(5) Thus since the business cards had not been copyrighted, the *Sears* and *Compco* decisions were said to preclude petitioner from seeking to recover from respondents the monetary value of the creation and development of the "Paladin" characterization which the jury found had been stolen from petitioner. See p. 13a, *infra*.

REASONS FOR GRANTING THE WRIT

The critical premise of the First Circuit's decision in this case is the notion that this Court's recent rulings in *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, and *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. 234, both of which dealt exclusively with invalid design patent matters, automatically and without qualification apply to works or writings that either fall or arguably fall within the ambit of the copyright clause of the Constitution and the copyright laws of the United States.

That premise is at best dubious. But the immediately pertinent fact is that this basic assumption, augmented by the precise rulings of the First Circuit, betrays several significant problems warranting this

Court's attention and consideration. Those problems, moreover, are not unique to this case; they have plagued all lower courts dealing with copyright matters in the post-*Sears-Compco* era. And the perplexities will remain until this Court definitively outlines the relationship of the *Sears-Compco* preemption doctrine to the copyright area.

1. Has the International News Service Decision Been Drained of Authoritativeness?

The First Circuit conceded that the decision of this Court in *International News Service* v. *Associated Press,* 248 U.S. 215, is "the leading case affording a remedy for mere copying." But that decision was said to be "no longer authoritative for at least two reasons: it was decided as a matter of general federal law before the decision in *Erie R.R.* v. *Tompkins,* 304 U.S. 64; and . . . it has clearly been overruled by the Supreme Court's recent decisions in *Sears, Roebuck & Co.* v. *Stiffel Co.,* 376 U.S. 225, and *Compco Corp.* v. *Day-Brite Lighting, Inc.,* 376 U.S. 234." See pp. 7a-8a, *infra.* Thereby raised are the following important questions deserving of this Court's concern:

(a) *International News Service* was indeed grounded on diversity jurisdiction, see 248 U.S. at 232, and presumably expressed a pre-*Erie* rule of general federal law. But if *Sears* and *Compco* are to be interpreted or extended to cover copyright situations, a serious problem is raised whether the resulting federal preemptive interest justifies the creation and continuation of federal rules of misappropriation in such copyright areas as were involved in *International News Service.*

The Court's opinion in *International News Service* exhibited complete awareness of the copyright provi-

sions of the Constitution and the provisions of the federal Copyright Act. The Court there carefully noted that its determination was not affected by any "showing that the benefits of the Copyright Act have been waived." 248 U.S. at 235. In other words, the result there reached was found to be consistent with the federal constitutional and statutory concepts governing copyrights. Nothing therein was thought to preclude protecting the Associated Press' interest in the "expenditure of labor, skill, and money" involved in the acquisition of written news material in a situation where an appropriator sought "to reap where it has not sown." 248 U.S. at 239.[1] And so in the instant case it could be concluded that to permit petitioner to be protected against respondents' piratical misappropriation of petitioner's creative efforts would in no real way be inconsistent with federal copyright concerns.

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[1] "The Copyright Act permits copyright protection against exact reproduction, but such protection does not preclude the public from using the factual information conveyed by the story. It seems clear that the Constitution permits this limited protection and that the states are precluded. But the Copyright Act would not seem to proscribe the INS practice of using the AP stories as a source of the underlying information and as the basis for its news stories, for the act does not protect the industry and judgment that the AP members expend in the gathering and selecting of facts. Judgment and industry are not 'writings'; the basic work of the reporter, like the results of the scientist and the mathematician, must, under the constitutional scheme, be available to the public, at least insofar as congressional power is concerned. The states are, therefore, free to grant protection similar to that which they may grant to other nonwriting elements, subject to possible limitations arising from the constitutional guarantee of freedom of the press." Kalodner and Vance, The Relation Between Federal and State Protection of Literary and Artistic Property, 72 Harv. L. Rev. 1079, 1106 (1959).

At the same time, however, the relationship between the misappropriation of creative nonwriting efforts and the precise copying of copyrightable material which is the concern of the Copyright Act may be considered so close as to justify encompassing both matters under the federal preemptive umbrella. Assuming *Sears* and *Compco* are to be fully applicable to the copyright field, this may then be a situation where the *Erie* doctrine has been held to be inapplicable, it being one of "those areas of judicial decision within which the policy of the law is so dominated by the sweep of federal statutes that legal relations which they affect must be deemed governed by federal law having its source in those statutes, rather than by local law." *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U.S. 173, 176. And in those situations like the present one where no precise answer is found in the federal statute, it becomes "the duty of the courts to be alert to provide such remedies as are necessary to make effective the congressional purpose." *J. I. Case Co.* v. *Borak*, 377 U.S. 426, 433.

The present case affords a convincing illustration of the need for and appropriateness of applying a uniform federal rule of misappropriation of material within the potential copyright realm. As indicated in footnotes 3 and 7 of the First Circuit's opinion, pp. 5a, 9a, *infra*, no single state's law can effectively cover a multi-state tort such as is here involved; there are grave difficulties involved even in determining which law of a state to apply—the local substantive law or the local conflicts law. See also *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 113, note 1, a post-*Erie* case where federal precedents were utilized. Thus it becomes essential that this Court lay down basic guidelines for establishing uniform federal rules

of law in this area, rules which very well may include the *International News Service* doctrine. Only in that way can incompatible and inconsistent doctrines of local law be avoided, once the *Sears-Compco* preemptive doctrine has been recognized in the copyright area. Cf. *Colorado Anti-Discrimination Comm'n* v. *Continental Air Lines*, 372 U.S. 714, 722; *Teamsters Union* v. *Morton*, 377 U.S. 252, 258.

(b) A closely related problem raised by the First Circuit's decision is whether this Court in *Sears* and *Compco* "clearly . . . overruled" the *International News Service* determination. Certainly no mention was made of that determination in either the *Sears* or the *Compco* opinion.[2] And the obvious differences between the design patent context of *Sears* and *Compco* and the copyright context of *International News Service* may well have induced this Court to defer any reconsideration of *International News Service* until compelled to do so in a case unavoidably presenting the question whether the federal copyright laws preempt any common law effort to prevent copying or appropriation of written material.[3]

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[2] It has been said that "Our understanding of Sears and Compco would be greatly increased, if only the Court had mentioned I.N.S." Bricker, Thirty Months After Sears and Compco, 14 Bull. Copyright Soc'y 293, 300 (1967). But it has also been said that "It would not be sensible to suppose that all of the precedents [including *International News Service*] have been displaced, *sub silentio*, by these two opinions." Bender, in Symposium—Product Simulation: A Right or a Wrong, 64 Colum. L. Rev. 1228, 1238 (1964).

[3] "American legal thinking on the subject of intellectual property has suffered, *ab initio*, from the lazy man's impulse to treat patents and copyrights alike, without a careful consideration of the vital differences between them." Whicher, The Ghost of Donaldson v. Beckett: An Inquiry Into the Constitutional Distribution of Powers Over the Law of Literary Property in the United States, 9 Bull. Copyright Soc'y 102, 194 n.4 (1962).

To permit a lower court to proclaim under these circumstances that *International News Service* has "clearly" been overruled is to encourage doubt, confusion and inconsistency among lower courts. Even in this post-*Sears-Compco* period, the *International News Service* ruling has been frequently cited and followed by lower courts seeking to protect the misappropriation of literary and written work.[4] Judges as well as litigants are now entitled to know whether in fact the *International News Service* decision has been overruled or whether the First Circuit's *ipse dixit* to that effect may safely be ignored.

2. Should the Sears-Compco Preemption Doctrine Be Applied Indiscriminately to the Copyright Area?

Since both *Sears* and *Compco* were concerned solely with products susceptible to whatever protection federal patent law alone might provide, there was no occasion for the Court to rule definitively on the preemptive reach of federal copyright law. Nevertheless, certain broad observations appear in both opinions relative to the relationship between federal copyright

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[4] Among such recent decisions utilizing the *International News Service* precedent are *Pottstown Publishing Co.* v. *Pottstown Broadcasting Co.*, 247 F. Supp. 578 (E.D. Pa.); *Flexitized, Inc.* v. *National Flexitized Corporation*, 335 F.2d 774 (C.A. 2); *The Bond Buyer* v. *The Dealers Digest Publishing Co., Inc.*, 25 App. Div. 2d 158, 267 N.Y.S. 2d 944; *Flamingo Telefilm Sales, Inc.* v. *United Artists Corp.*, 141 U.S.P.Q. 461 (N.Y. Sup. Ct.).

law and state law of unfair competition.[5] These statements are epitomized by the sentence in *Compco,* 376 U.S. at 237, reading: "Today we have held in *Sears, Roebuck & Co.* v. *Stiffel Co., supra,* that when an article is unprotected by a patent *or a copyright,* state law may not forbid others to copy that article." [Emphasis added.]

Some lower courts have stressed that these copyright references are *obiter dictum.* See, e.g., *Pottstown Publishing Co.* v. *Pottstown Broadcasting Co.,* 247 F. Supp. 578, 580-581 (E.D. Pa.). Others have suggested that *Sears* and *Compco* were not designed to strike down common law copyright principles, which are preserved in § 2 of the Copyright Act and which are referred to in footnote 7 of the *Sears* opinion. 376 U.S. at 231. As stated in *Edgar H. Wood Associates, Inc.* v. *Skene,* 347 Mass. 351, 197 N.E. 2d 886, 890: "There is a distinction between that protection afforded under State unfair competition laws to the unpatented article in the public domain and the protection extended through common law copyright to an unpublished work."

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[5] The very first sentence in *Sears,* 376 U.S. at 225, states the issue to be whether a state unfair competition law may "prohibit the copying of an article which is protected by neither a federal patent nor a copyright." And after discussing patent policy and history, the Court in *Sears* concludes that "because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying." 376 U.S. at 232-233. The *Compco* opinion, 376 U.S. at 237, added that "to forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

Indeed, contrary to the First Circuit's indiscriminate reading of the *Sears-Compco* decisions, it has been claimed that "the very fact that the federal copyright system is not so comprehensive as the patent law—passingly noted in *Sears*—suggests that the preemption principles expounded in *Sears* and *Compco* were not intended to resolve problems peculiar to the copyright law." Kestenbaum, The *Sears* and *Compco* Cases: A Federal Right To Compete by Copying, 51 A.B.A.J. 935, 938 (1965). Thus it may well be that *Sears* and *Compco*, dealing only with unpatented and uncopyrighted articles of a commercial or industrial nature, meant to emphasize only that such an "article . . . unprotected by a patent or copyright," may be freely copied. This would leave untouched by *Sears* and *Compco* those writings and literary characterizations that do not partake of the nature of commercial or industrial articles.

Moreover, with specific reference to the protectability of literary or artistic characters outside the federal copyright scheme, serious questions have been raised whether this Court in *Sears* and *Compco* meant to outlaw the extensive jurisprudence which has developed in federal and state courts protecting creators of characterizations against piracy. Did this Court mean, for example, to permit free appropriation by anyone of the effort and expense that went into the creation and development of such uncopyrighted and uncopyrightable characters as Mutt and Jeff,[6] the "Old

[6] Protection against unfair appropriation of these characters was afforded in *Fisher* v. *Star Co.*, 231 N.Y. 414.

Maestro,".[7] Frank Merriwell,[8] Stella Dallas,[9] Raggedy Ann,[10] Charlie Chaplin,[11] the Lone Ranger,[12] the Beatles,[13] and Wyatt Earp?[14] It has been said that running through all the cases giving protection to such characterizations is a single thread, i.e., "the character was associated with and therefore identified the author or the characterization identified the performer [and the] use by another of this identification was an invasion of the author's or the performer's right to his identity and it is this right which the courts protected." Waldheim, Characters—May They Be Kidnapped? 12 Bull. Copyright Soc'y 210, 215 (1965). But the ultimate and unanswered question is the one asked by this commentator (Waldheim, p. 217): "Does the Supreme Court imply by these cases [*Sears* and *Compco*] that the only rights inhering in a character are those which are afforded by the copyright law?"

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[7] Protection against appropriation was given in *Premier-Pabst Corporation* v. *Elm City Brewing Co.*, 9 F. Supp. 754 (D. Conn.).

[8] Protection afforded in *Patten* v. *Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y.).

[9] Protection afforded in *Prouty* v. *National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass.).

[10] Protection afforded in *Gruelle* v. *Molly-'Es Dolls Outfitters*, 94 F. 2d 172 (C.A. 3).

[11] Protection afforded in *Chaplin* v. *Amador*, 93 Cal. App. 358, 269 P. 544.

[12] Protection afforded in *Lone Ranger* v. *Cox*, 124 F. 2d 650 (C.A. 4).

[13] Protection afforded in *Remco Industries* v. *Goldberger Doll Mfg. Co.*, 141 U.S.P.Q. 898 (E.D.N.Y.).

[14] Protection afforded in *Wyatt Earp Enterprises* v. *Sackman*, 157 F. Supp. 621 (S.D.N.Y.).

The First Circuit has sought to answer that question in the affirmative. To do so, however, raises a host of complexities. To strip characterizations of all protection other than that afforded by the copyright laws of the United States is to allow a chilling breeze on First Amendment rights; unlike commercial products, literary creations partake of freedom of speech and press and to denude them of such protection may well inhibit creativity and expression. And such creations would not seem to fit within the normal concept of the commercial goods and articles which are involved in "the constitutional plan of a competitive economy," *Aro Mfg. Co.* v. *Convertible Top Co.*, 377 U.S. 476, 572 (Black, J.), the plan which *Sears* and *Compco* are designed to preserve.

Indeed, it is not at all clear the extent to which characterizations can claim the limited protection of the copyright laws.[15] And even if they can claim copyright protection, neither the copyright clause of the Constitution nor the Copyright Act does more than outlaw mere copying. Those provisions leave untouched and unpunished any piracy of the creative effort and development that ultimately make possible a copyrightable work. Hence to permit a state law of unfair competition to give protection against appropriation of such effort and development would not appear, in the words of *Sears*, 376 U.S. at 232, "to permit the State to block off from the public something which federal law has said belongs to the public." Federal law does not here say that the creative and

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[15] The best that can be said on this matter is that "the courts are in conflict on this issue." Nimmer on Copyright, § 30, p. 134.1 (1967). And see Waldheim, Characters—May They Be Kidnapped? 12 Bull. Copyright Soc'y 210 (1965).

developmental efforts underlying a literary characterization belong to the public. Or, as put in *Ferris* v. *Frohman*, 223 U.S. 424, 437, "It was not the purpose or effect of the copyright law to render secure the fruits of piracy."

It may fairly be said that the *Sears* and *Compco* decisions leave the law in this area of literary characterizations "in a confusing state". Bricker, Thirty Months After Sears and Compco, 14 Bull. Copyright Soc'y 293, 309 (1967). Already at least one federal district court has tried without success to interpret and apply *Sears* and *Compco* in terms of the protection now available to a literary characterization like Tarzan. *Edgar Rice Burroughs, Inc.* v. *Charlton Publications, Inc.*, 243 F. Supp. 731 (S.D.N.Y.). The First Circuit's efforts in the instant "Paladin" case are no more satisfactory.

Only this Court's consideration can bring any degree of certainty or clarity to this constantly recurring situation.[16]

3. What Copyright Protection Is Available to a Literary Characterization?

Neither courts nor commentators are in agreement as to the extent to which literary and artistic characterizations are subject to copyright protection, be it of the common law or federal statutory variety. The decision of the First Circuit in this case has only

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[16] *Sears* and *Compco*, according to one commentator, "have not been unanimously acclaimed by the lower courts. They have been treated sarcastically, doubtfully, and apparently incorrectly. For other courts sharp differences of opinion have arisen." [Citing cases.] Bricker, Thirty Months After Sears and Compco, 14 Bull. Copyright Soc'y 293, 302 (1967).

added to that confusion, making it appropriate for this Court to exercise its certiorari review power.

(a) In denying that literary characters are inherently uncopyrightable, see p. 10a, *infra*, the First Circuit has expressed a viewpoint in conflict with the view of the Ninth Circuit in *Warner Bros. Pictures* v. *Columbia Broadcasting System*, 216 F. 2d 945, and of a host of other federal courts.[17] While the First Circuit attempted to distinguish the *Warner* case on its facts, a plain reading of the Ninth Circuit's opinion reveals that it held that no character is protectible under the federal copyright law unless "the character really constitutes the story being told", and is not merely a "chess man in the game of telling the story"—in other words, there must be a "story" devoid of everything but a character study. 216 F. 2d at 950. No such "story" was involved in the instant case, thereby making the conflict complete.

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[17] Other lower federal courts that have held literary characterizations generally to be non-copyrightable include *Bobbs-Merrill* v. *Straus*, 147 F. 15 (C.A. 2); *Universal Pictures Co.* v. *Harold Lloyd Corp.*, 162 F.2d 690 (C.A. 2).

Contrary views have been expressed in such cases as *Lone Ranger, Inc.* v. *Cox*, 124 F.2d 650 (C.A. 4); *King Features Syndicate* v. *Fleisher*, 299 F. 533 (C.A. 2); and *Wilson* v. *Haber Bros.*, 275 F. 346 (C.A. 2).

As stated in Nimmer on Copyright, § 30, p. 134.1 (1967), where all the conflicting decisions are cited, these courts "are in conflict on this issue," although an argument can be made that there is a degree of reconcilability in terms of the degree to which a character has been delineated in a literary work. As stated by Judge Learned Hand in *Nichols* v. *Universal Pictures*, 45 F.2d 119, 121 (C.A. 2), "the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."

Indeed, the general or majority view of courts and commentators always has been that "ordinarily, of course, there is no copyright protection in a character as such" [18]—which is precisely what the petitioner here created and nothing more. And it is significant that the Federal Register of Copyrights, in reporting to the House Committee on the Judiciary on proposed revisions of the federal copyright law, has stated that "we believe it would be unnecessary and misleading to specify fictional characters as a separate class of copyrightable works." [19] He thereby implied that characters as such are not now copyrightable and should not be made copyrightable.

There is an obvious need for clarification of this problem by this Court.

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[18] Waldheim, Characters—May They Be Kidnapped? 12 Bull. Copyright Soc'y 210 (1965). See also *Burtis* v. *Universal Pictures*, 40 Cal. 2d 823, 256 P.2d 933: "Although it might be possible that an author could so carefully delineate a character as to secure a protectible property interest in that character, generally it is held that a character is not included within the monopoly of copyright."

[19] His full statement reads: "Proposals have been advanced for identifying fictional characters as copyrightable works in themselves under the bill. There are undoubtedly some characters that are developed in detail and with such breadth and depth that they emerge as separately identifiable parts of the copyrighted works in which they appear. Others, perhaps the large majority, cannot be said to represent independent creations apart from the particular literary or pictorial works depicting them. As is equally true in the case of detailed presentations of plot, setting, or dramatic action, we believe it would be unnecessary and misleading to specify fictional characters as a separate class of copyrightable works."

Copyright Law Revision, Part 6, Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill, House Committee on the Judiciary Print, 89th Cong., 1st Sess. (May 1965), p. 6.

(b) An integral part of the First Circuit's ruling that petitioner's characterization of Paladin was copyrightable is its insistence (see pp. 11a, 13a, *infra*) that such characterization involves a "writing" within the meaning of federal copyright law. But in trying to define the form of "writing" which a characterization may take for copyright purposes, the court has only compounded the confusion over the copyrightability of literary characters.

Ignoring the general rule that a creation must involve some identifiable, durable and material form to be copyrightable,[20] the First Circuit has said first that congressional power over copyright matters is not so limited. But the court is not certain precisely what aspect of a personal characterization becomes subject to that legislative power. The court suggests it would not be "impracticable" to provide for a procedure for registering "characters" by filing some sort of pictorial or narrative description—a suggestion which the Register of Copyrights has found to be wholly impracticable and unwise. Finally, almost in desperation, the First Circuit has concluded that perhaps we have here reached the point "where what is created is so slight a thing as not to warrant protection by any law . . . [and] ineligible for protection against copying *simpliciter* under either state or federal law." See pp. 11a-12a, *infra*.

Thus the First Circuit finally seems to be saying, contrary to its own earlier statements, that personal or literary characterizations are inherently uncopyrightable and not entitled to any sort of legal protection.

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[20] See Nimmer, Copyright Publication, 56 Colum. L. Rev. 185, 196 (1956).

But if that be true, what becomes of the federal preemptive interest which the court has found to be so great as to bar any relief in this case under state law? If the subject matter is "so slight a thing" as to be ineligible for federal protection, what power does a federal court have to declare it to be ineligible for state protection? These are only a few of the questions arising from the First Circuit's strange ruling. Left unchallanged, that ruling can only breed chaos and uncertainty in the field of literary characterization.

(c) Finally, the First Circuit's conclusion that petitioner's creation was not an unpublished work under 17 U.S.C. § 2 and hence was not protectible under common law copyright doctrines creates conflicts with principles announced by this Court and raises important issues fully justifying this Court's concern.

In holding that petitioner had abandoned his characterization by performing in public and handing out business cards to all who would take them, the First Circuit (1) overrode the jury's unchallenged determination, based on record evidence (R. App. 78-80, 98-99, 106, 154) as to the limited purpose and intent of the distribution, that there had been no publication and (2) redefined *de novo* the characterization so as to fit completely within the portrayals and wording of the business cards. The court thereupon held that the cards were the "writings" that had been published for purposes of § 2 and that could have been but were not copyrighted.

Such a ruling only underscores and augments the internal confusion in the First Circuit's opinion over what if any aspect of a characterization is a copy-

rightable "writing." More importantly, however, the court has ignored certain basic principles recognized by this Court:

(1) To constitute a publication in the copyright sense, there "must be such a dissemination of the work of art itself among the public as to justify the belief that it took place with the intention of rendering such work common property." *American Tobacco Co.* v. *Werckmeister,* 207 U.S. 284, 299-300. Since that issue is largely a factual one, the jury's verdict—assuming proper instructions and sufficient evidence—must be respected by an appellate court in order to avoid a collision with the Seventh Amendment. See *Arnold* v. *Panhandle & S.F.R. Co.,* 353 U.S. 360; *A. & G. Stevedores* v. *Ellerman Lines,* 369 U.S. 355.

(2) The mere "public presentation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right . . . [or] an abandonment of it to the public use." *Ferris* v. *Frohman,* 223 U.S. 424, 435.[21] That basic principle should not be avoidable by the technique employed by the First Circuit, i.e., seizing upon one printed facet of a many-faceted characterization and elevating it into the sole characteristic. Actually the cards were mere adjuncts in aid of petitioner's public performances, which under the *Ferris* doctrine were properly found by the jury not to constitute publication or abandonment of

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[21] The cases that have employed this principle are legion. See, e.g., *Columbia Broadcasting System* v. *Documentaries, Unlimited,* 248 N.Y.S. 2d 809 (N.Y. Sup. Ct.), where one of the respondents in the instant case successfully urged that a public broadcast of a news announcement, presumably heard by millions of citizens, did not constitute an abandonment of common law copyright by publication.

the character. At most the cards, which might also qualify as trademarks or service marks, served to reinforce and strengthen the secondary meaning that attached to petitioner in his unabandoned role of Paladin. The cards themselves were not the characterization as viewed by the jury and their so-called publication could not as a matter of law constitute an abandonment of the characterization. In these circumstances, the *Ferris* rule should have been followed.

CONCLUSION

For these various reasons, a writ of certiorari should issue to review the judgment and opinion of the First Circuit in this case.

Respectfully submitted,

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